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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/517,163      | 04/05/2000  | Sadahiko Hinoue      | 1247-0424P-SP       | 6242             |

7590 05/19/2003

Birch Stewart Kolaasch & Birch LLP  
P O Box 747  
Falls Church, VA 22040-0747

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| EXAMINER |
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HELSELTINE, RYAN J

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2623

DATE MAILED: 05/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/517,163

Applicant(s)

HINOUE ET AL.

Examiner

Ryan J Hesseltine

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 11-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick et al. (USPN 5,420,936), hereafter Fitzpatrick, in view of Mori et al. (USPN 5,040,142), hereafter Mori.

3. Regarding claim 1, Fitzpatrick discloses an information processing apparatus comprising: fingerprint verification means for verifying a fingerprint read from a fingerprint reading surface against previously stored fingerprints of authorized users (column 3, line 52-65), the information processing apparatus further comprising: display means having a display surface with orthogonal coordinates set thereon (figure 3, element 50); coordinate designating means for designating coordinates related to fingerprint reading on the display surface (column 4, line 3-10); and control means (84) for controlling an operation based on designated coordinates (column 4, line 10-26). Fitzpatrick discloses that requiring a user to enter a password (secret number) through a keyboard terminal in order to obtain access to data accessible via the terminal is conventional (column 3, line 18-35), but does not explicitly disclose that the information processing apparatus further comprises a secret number acquiring means.

4. Mori discloses an electronic document review method comprising secret number acquiring means (143) for acquiring a secret number (column 5, line 4-11); and secret number

identifying means for verifying the acquired secret number against a previously stored secret number (column 8, line 64 to column 9, line 5), wherein the control means controls an operation based on a result of the secret number verification (column 9, line 5-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a secret number acquiring means as taught by Mori in order to further verify a user's identity and to look up any data for the user such as a seal or fingerprint image as well as integrating the fingerprint capturing and secret number acquiring into one device.

5. Regarding claim 2, Fitzpatrick discloses that the display surface and the fingerprint reading surface are one and the same (column 3, line 52-57).

6. Regarding claim 3, Fitzpatrick discloses that the fingerprint reading surface is formed on the coordinate designating means (column 4, line 3-10).

7. Regarding claim 4, Fitzpatrick discloses that the control means activates the fingerprint verification means when specific coordinates are designated (column 4, line 16-26).

8. Regarding claim 11, Fitzpatrick discloses that the information processing apparatus further comprises: icon setting means for setting an icon associated with an application (column 4, line 10-14); and icon designation judging means for judging whether the set icon is designated or not, based on designated coordinates (column 4, line 3-10), wherein when the icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means reads out only data of a user having the matching fingerprint in an application associated with the designated icon and causes the data to be displayed (column 4, line 14-26).

9. Regarding claim 12, Fitzpatrick discloses that when an icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means initiates an

application associated with a user having the matching fingerprint among applications previously set for the respective authorized users ("per-icon" access table 76, column 4, line 18-26).

10. Regarding claim 13, Fitzpatrick discloses that the respective icons are associated with files for the respective authorized users; and when an icon is designated and there is a match in fingerprint as a result of the fingerprint verification, the control means opens only a file (program/data) of a user having the matching fingerprint out of files associated with the designated icon (column 4, line 18-26).

11. Regarding claim 15, Fitzpatrick does not disclose the processing of a document having a seal box. Mori discloses that a document having a seal box is displayed on the display means (column 5, line 1-19); and when detected coordinates are coordinates of the seal box (column 4, line 45-47), the control means affixes an approval seal in the seal box of the document, the information processing apparatus further comprising: communication means for communicating an approval-seal affixed document (column 4, line 53-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to process a document having a seal box as taught by Mori in order to securely process shared documents and allow for approval/review of the documents (column 3, line 49-65).

12. Regarding claim 16, Fitzpatrick does not disclose the processing of a document having a seal box utilizing approval request processing. Mori discloses that a document having a seal box is displayed on the display means; and when detected coordinates are coordinates of the seal box, the control means affixes an approval seal in the seal box of the document (see discussion of claim 15 above), the information processing apparatus further comprising: approval request processing means for subjecting an approval-seal affixed document to an approval request

processing (column 3, line 66 to column 4, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to process a document having a seal box using approval request processing as taught by Mori in order to securely process shared documents and allow for the documents to be reviewed/approved by a plurality of users.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Mori as applied to claim 1 above, and further in view of Matsumura (USPN 5,493,621).

14. Fitzpatrick does not disclose that the fingerprint verification means is activated when the secret numbers match each other. Matsumura discloses a fingerprint identification system and method wherein the control means activates the fingerprint verification means when the secret numbers match each other (column 11, line 44-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to activate the finger verification when the secret numbers match as taught by Matsumura in order to increase security and to reduce the time it takes to compare fingerprints since a user's fingerprint can be compared with a smaller subset of prints.

15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Mori as applied to claim 1 above, and further in view of Angelo (USPN 5,887,131).

16. Fitzpatrick does not disclose operation of a power source when there is a fingerprint match. Angelo discloses an access control method for a computer system wherein a control means controls the operation of a power source of the information processing apparatus (column 8, line 7-34) when there is a match in fingerprint (column 7, line 26-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate a power

source when there is a fingerprint/password match as taught by Angelo in order to prevent repeated attempts to gain unauthorized access to the system.

17. Claims 8-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Mori as applied to claim 1 above, and further in view of Shieh (USPN 5,874,948).

18. Regarding claim 8, Fitzpatrick does not disclose reading an operating condition associated with each user. Shieh discloses when there is a match as a result of the verification of the read fingerprint against the previously stored fingerprints, the control means reads out an operation condition associated with an authorized user having the matching fingerprint from among operation conditions previously set for the authorized users and sets the condition (column 4, line 28-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to read an operating condition associated with each user as taught by Shieh in order to allow users to customize their working environment.

19. Regarding claim 9, Fitzpatrick does not expressly disclose that all fingers on both hands can be verified. Shieh discloses that the fingerprint verification means is capable of verifying fingerprints of all fingers of both hands (column 3, line 55-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to verify all fingers of both hands as taught by Shieh in order to associate commands with each identifying feature.

20. Regarding claim 10, Fitzpatrick does not disclose associating a command with each finger of the user. Shieh discloses that when the fingerprints of the respective fingers match the previously stored ones, the control means reads out a command associated with each finger of the user having the matching fingerprints, from among commands previously registered for the

Art Unit: 2623

respective fingers of the authorized user and executes the commands (figure 2; column 5, line 1-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to associate commands with each finger as taught by Shieh in order to give the user shortcut functions at their fingertips, and to allow further customization.

21. Regarding claim 14, Fitzpatrick does not expressly disclose the use of menus. Shieh discloses that the information processing apparatus further comprises: menu execution level area setting means for setting an area associated with an execution level of a menu (column 5, line 10-18; column 6, line 7-12); and menu execution level area designation judging means for judging based on designated coordinates whether a set menu execution level area is designated or not (column 3, line 15-23), wherein when a menu execution level area is designated and there is a match in fingerprint, the control means executes a menu at an execution level associated with an authorized user having the matching fingerprint among execution levels previously set for the respective users (column 4, line 28-42), as well as an execution level of the designated menu execution level area (column 5, line 30-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the use of menus as taught by Shieh in order to allow the added functionality of a plurality of functions hidden in a drop down menu or the like.

### ***Response to Arguments***

22. In view of applicant's amendment filed March 10, 2003, the objections with respect to the drawings, title, and claim 13, and the 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection with respect to claim 16 are withdrawn.



23. Applicant's arguments filed March 10, 2003 have been fully considered but they are not persuasive.

24. Regarding applicant's arguments with respect to Fitzpatrick and Mori on page 8, second and third paragraphs continuing on to page 9, second paragraph, applicant states, "Mori does not disclose ... authentication using fingerprint reading. Mori disclose authentication by inputting a password into a window of a display, but that password is not acquired, for example, based on coordinates of the window." Examiner agrees with this assertion, but reminds applicant that Fitzpatrick discloses all claimed subject matter including authentication using fingerprint reading and acquiring fingerprint data based on coordinates of the window. In fact, Fitzpatrick suggests the use of a password since it is well known in the art to control access using a password (column 3, line 18-35). Mori indeed discloses authentication by inputting a password into a window of a display, and therefore it is an obvious modification of Fitzpatrick to include this type of secret number acquiring means to further increase security and to integrate the fingerprint capturing and secret number acquiring into one device (see above discussion of claim 1).

25. Regarding applicant's arguments with respect to Matsumura on page 10, second paragraph, applicant states, "Matsumura's password is not based on a designated coordinate and the designated coordinate is not related to fingerprint reading." Examiner agrees with this assertion, but again points out that Fitzpatrick discloses all claimed subject matter including authentication using fingerprint reading and acquiring fingerprint data based on coordinates of the window, and suggests the use of a password since it is well known in the art to control access using a password. Fitzpatrick does not disclose that the fingerprint verification means is

activated when the secret numbers match each other, but it is an obvious modification of Fitzpatrick to do so (see above discussion of claim 6).

26. Regarding applicant's arguments with respect to Angelo on page 11, first paragraph, applicant states, "Angelo fails to make up for the deficiency of Fitzpatrick of failing to teach a secret number acquiring means, secret number identifying means, and control means." Please refer to above discussion in reference to Fitzpatrick in view of Mori as applied to claim 1.

Applicant further states, "Angelo does not teach operation of a power source when there is a match in fingerprint." Examiner respectfully disagrees. Angelo discloses the operation of a power source of the information processing apparatus (column 8, line 7-12) when there is a match in fingerprint (column 7, line 26-33). Angelo discloses that this fingerprint in the form of a plain text password, but since the password was created from the fingerprint, a match in plain text passwords indicates a match in fingerprint (see above discussion of claim 7).

27. Regarding applicant's arguments with respect to Shieh on page 11, last paragraph on to page 12, second paragraph. Applicant states, "Shieh fails to make up for the deficiency of Fitzpatrick of failing to teach a secret number acquiring means, secret number identifying means, and control means." Please refer to above discussion in reference to Fitzpatrick in view of Mori as applied to claim 1. Regarding claim 14, applicant further states, "there is no disclosure of execution level associated with a user and execution level of a menu area in Shieh." Examiner respectfully disagrees. Shieh discloses that once the operating system (OS) finds a match within a user defined acceptable tolerance; the OS reads the user file for predefined customization features (execution level associated with a user; column 4, line 28-42). Shieh further discloses menu level execution using pull-down menus (column 3, line 19-23) as well as default menus

(column 5, line 30-32) and a main menu (column 6, line 7-12). It would have been an obvious modification of Fitzpatrick to include the use of menu level and user level execution.

***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,978,477 to Hull et al. discloses an automatic and transparent document archiving system including user ID data received from a touch screen.

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069. The examiner can normally be reached on Monday - Friday, 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the

Application/Control Number: 09/517,163


Page 11

Art Unit: 2623

organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

rjh  
May 14, 2003

  
AMELIA M. AU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600